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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,083	09/27/2005	Matthew Albert Ivey	PU030095	4286
24498	7590	04/04/2008		
Joseph J. Laks Thomson Licensing LLC 2 Independence Way, Patent Operations PO Box 5312 PRINCETON, NJ 08543			EXAMINER  LEE, WILSON	
			ART UNIT  2163	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/551,083

**Applicant(s)**

IVEY ET AL

**Examiner**

Wilson Lee

**Art Unit**

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/55/08)  
Paper No(s)/Mail Date 9-27-05, 9-21-06, 4-25-07
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_

**Claim Rejections – 35 U.S.C. 101**

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 20 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claim 20, although the claim is directed to a system for automatically generating a slate using metadata, however, "means for receiving a request..." and "means for generating the slate..." are seemingly software components shown on the monitor screen which do not fit within any patentable categories such as process, machine, manufacture, composition of matter, as set forth in 35 U.S.C. 101.

The claim is seemingly a computer program-generated product and is not embodied on a computer readable storage medium. A claim that recites a piece of software alone without any link to a hardware component (computer readable storage medium) is directed to non-statutory subject matter. It is not patent eligible subject matter in accordance with *In re Warmerdam*, 31 USPQ 2d, 1354.

Claim 21 is rejected under 35 U.S.C. 101 because the disclosed invention is non-statutory subject matter and inoperative.

In Claim 21, lines 2-3, "computer program logic" is not further specified that it is computer-executable. The program appears inoperative if the claim does not state that it could be executed by a computer. Further, the claimed "program code" fails fit within any patentable categories such as process, machine, manufacture, composition of matter, as set forth in 35 U.S.C. 101. A claim that recites a piece of software alone without any link to a hardware component (computer readable storage medium) is directed to non-statutory subject matter. It is not patent eligible subject matter in accordance with *In re Warmerdam*, 31 USPQ 2d, 1354.

**Claim Rejections – 35 U.S.C. 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (US Publication 2002/0073422).

Regarding Claim 1, Lee discloses a method for automatically generating a slate using metadata, the method comprising: receiving a request (from fig. 8) to generate a slate ("slate" is interpreted as a command or scheduled recording on the particular program requested by user. paragraph 0006), wherein the request is associated with a selected video media asset (e.g. Baseball games. Fig. 8); and generating the slate using metadata associated with the selected video media asset (e.g. Baseball games).

Regarding Claim 2, Lee discloses the method of claim 1, further comprising: providing a list of video media assets ("...displays the list of the programs that were advertised." paragraph 0040) to a user so the user can select a video media asset to have a slate generated ("the viewer may select the program by pushing a numerical button...") (paragraph 0040, lines 1-21).

Regarding Claim 3, Lee discloses the method of claim 1, further comprising: acquiring metadata associated with the selected video media asset (paragraph 0033 and fig. 8).

Regarding Claim 4, Lee discloses the method of claim 3, further comprising: creating a preview of the slate, wherein the preview is created by generating fields that are associated with the acquired metadata (Figs. 1, 9 and paragraphs 0002, 0029 and abstract).

Regarding Claim 5, Lee discloses the method of claim 4, further comprising: adjusting the preview of the slate in response to the user (note that the preview can be adjusted or changed by choosing other programs shown in figure 8).

Regarding Claim 6, Lee discloses the method of claim 5, wherein the properties of the previewed slate are adjusted (note that the title, date, time, channel, type, etc., can be adjusted) (figs. 3, 9) (in claim 1, "updating means that changes operations that is to be operated on said chosen programs").

Regarding Claim 7, Lee discloses the method of claim 5, further comprising: receiving an acceptance of the preview, wherein the slate is generated after receiving the acceptance (Lee teaches that viewer can review (preview) the detailed information by push REVIEW 104. After the viewer pushes the SP, the content will become "slate". paragraph 0033).

Regarding Claim 8, Lee discloses the method of claim 1, wherein the generating step further comprises: rendering frames (data) of the slate (fig. 3) with its associated metadata; compressing the frames (data) of the slate ("In order to reduce the amount of information to be transmitted, the text program information may be compressed...", paragraph 0040, lines 31-35; "...the remaining information may be compressed...., paragraph 0036); and converting the compressed frames (data) into a video stream (converting from coder/decoder into viewable video. Paragraph 0029).

Regarding Claim 9, Lee discloses the method of claim 8, wherein the compressed frames are converted into a video media asset stream using a general exchange format (digital format) (paragraph 0029).

Regarding Claim 10, Lee discloses the method of claim 8, further comprising: sending the video stream to a server (server is interpreted as an application or device that performs services for client) for storage (note that television has a recording means for storing all the video or program) (paragraph 0006).

Regarding Claim 11, Lee discloses the method of claim 8, further comprising: editing the video stream into the selected video media asset (Claim 1 of Lee, "updating means that changes operations....". Updating means editing).

Regarding Claim 12, Lee discloses an apparatus for presenting metadata on a video-slate, wherein the metadata is in a text format ("text program". Paragraph 0040), the apparatus comprising: a memory device for storing a program; a processor in communication with the memory device, the processor operative with the program to: receive a request to generate a slate ("slate" is interpreted as a

command or scheduled recording on the particular program requested by user. paragraph 0006), wherein the request is associated with a selected video media asset (e.g. Baseball games. Fig. 8); and generate the slate using metadata associated with the selected video media asset (e.g. Baseball games).

Regarding Claim 13, Lee discloses the apparatus of claim 12, the processor further operative with the program to: provide a list of video media assets ("...displays the list of the programs that were advertised." paragraph 0040) to a user so the user can select a video media asset to have a slate generated ("the viewer may select the program by pushing a numerical button...") (paragraph 0040, lines 1-21).

Regarding Claim 14, Lee discloses the apparatus of claim 12, the processor further operative with the program to: acquire metadata associated with the selected video media asset. (paragraph 0033 and fig. 8).

Regarding Claim 15, Lee discloses the apparatus of claim 14, the processor further operative with the program to: create a preview of the slate, wherein the preview is created using fields that are associated with the acquired metadata (Figs. 1, 9 and paragraphs 0002, 0029 and abstract).

Regarding Claim 16, Lee discloses the apparatus of claim 15, the processor further operative with the program to: adjust the preview of the slate in response to the user. (note that the preview can be adjusted or changed by choosing other programs shown in figure 8).

Regarding Claim 17, Lee discloses the apparatus of claim 15, the processor further operative with the program to: receive an acceptance of the preview, wherein the slate is generated after receiving the acceptance (Lee teaches that viewer can review (preview) the detailed information by push REVIEW 104. After the viewer pushes the SP, the content will become "slate". paragraph 0033).

Regarding Claim 18, Lee discloses the apparatus of claim 12, the processor further operative with the program to: transmit the generated slate to a server (server is interpreted as an application or device that performs services for client) for storage (note that television has a recording means for storing all the video or program) (paragraph 0006).

Regarding Claim 19, Lee discloses the apparatus of claim 12, the processor further operative with the program to: edit the generated slate into the selected video media asset (Claim 1 of Lee, "updating means that changes operations....". Updating means editing).

Regarding Claim 20, Lee discloses a system for automatically generating a slate using metadata, the system comprising: means for receiving a request to generate a slate ("slate" is interpreted as a command or scheduled recording on the particular program requested by user. paragraph 0006), wherein the request is associated with a selected video media asset (e.g. Baseball games. Fig. 8); and means for generating the slate using metadata associated with the selected video media asset (e.g. Baseball games).

Regarding Claim 21, Lee discloses a computer program product comprising a computer useable medium having computer program logic recorded thereon for automatically generating a slate using metadata, the computer program logic comprising: program code for receiving a request to generate a slate ("slate" is interpreted as a command or scheduled recording on the particular program requested by user. paragraph 0006), wherein the request is associated with a selected video media asset (e.g. Baseball games. Fig. 8); and program code for generating the slate using metadata associated with the selected video media asset (e.g. Baseball games).

Regarding Claim 22, Lee disclose a method for presenting metadata on a video-slate that is viewable as a video stream, the method comprising: receiving a request to provide a user with a list of video media assets so the user can select a video media asset (e.g. Baseball games. Fig. 8) to have a slate generated ("slate" is interpreted as a command or scheduled recording on the particular program requested by user. paragraph 0006); providing the list of video media assets ("...displays the list of the programs that were advertised." paragraph 0040) to the user, wherein the list of video media assets ("list of the programs") is acquired from a media database (hard disk in Television station) in a media server; receiving a selected a video media asset from the user ("the viewer may select the program by pushing a numerical button...") (paragraph 0040, lines 1-21); acquiring metadata associated with the selected video media asset (paragraph 0033 and fig. 8), wherein the metadata is acquired from a metadata database (hard disk) in the media server; creating a preview of the slate, wherein the preview is created by

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generating fields that are associated with the acquired metadata (Figs. 1, 9 and paragraphs 0002, 0029 and abstract); generating the slate in response to the user's acceptance of the preview (Lee teaches that viewer can review (preview) the detailed information by push REVIEW 104. After the viewer pushes the SP, the content will become "slate". paragraph 0033), wherein the slate is converted into a video stream, transmitting the video stream to the media server ("In order to reduce the amount of information to be transmitted, the text program information may be compressed...", paragraph 0040, lines 31-35; "...the remaining information may be compressed..., paragraph 0036);; and editing the video stream into the selected video media asset so the video stream can be viewed in conjunction with the selected video media asset. (Claim 1 of Lee, "updating means that changes operations....". Updating means editing).

Regarding Claim 23, Lee discloses a method of using the metadata of the method of claim 1, watermark ("SP 20:37 7 15 15:00 2:00") a copy of the selected media video asset (figs. 1, 12, 13).

### **Conclusion**

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. March (US 2004/0003403) discloses a method and system for reducing information in electronic program guide and program recommendation systems. Hoffert et al. (USP 6,374,260) discloses a method and apparatus for uploading, indexing, analyzing and searching media content.

### **Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Wilson Lee whose telephone number is (571) 272-1824.

Papers related to the application may be submitted by facsimile transmission. Any transmission not to be considered an official response must be clearly marked "DRAFT". The official fax number is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you



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have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Wilson Lee/  
Primary Examiner, Art Unit 2163

3.31.08